

Our Docket No.: 42P6485C

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

In re Application of:)
Williams, Christopher D.)
Application No.: 10/627,085) Examiner: Schnurr, John R.
Filed: July 24, 2003) Art Group: 2421
For: Method and Apparatus for Channel)
Surfing Through Multiple Sources)
Based on User-Definable Preferences)

Mail Stop: Appeal Brief - Patents
P.O. Box 1450
Alexandria, VA 22313-1450

REPLY BRIEF
IN SUPPORT OF APPELLANT'S APPEAL
TO THE BOARD OF PATENT APPEALS AND INTERFERENCES

Sir:

Applicant (hereinafter “Appellant”) hereby submits this Reply Brief (hereinafter “Reply”) in response to the Examiner’s answer of June 10, 2010 in the above-referenced Application. Appellant respectfully requests consideration of this appeal by the Board of Patent Appeals and Interferences (hereinafter “Board”) for allowance of the above-captioned patent application.

An oral hearing is not desired.

REPLY

A. Statutory Subject Matter

The Examiner has rejected claims 1-14 under 35 U.S.C. §101 as not falling within one of the four statutory categories of invention. Appellant apologizes for the error in stating that this was a new rejection presented on final. As stated by the Examiner, this rejection was also raised in the earlier June 19, 2009 rejection.

In light of the Supreme Court's ruling three days ago in *In re Bilski* Appellants defer substantive argument at this time.

As to Claim 1, as stated previously, Appellants believe that the storage and display of the lists is sufficient under the machine or transformation test. It is not necessary that every operation be tied to the machine. Appellants would be willing to amend the claim to recite "receiving a user choice ... list display at a user interface of a channel selector" if this were considered by the Board to be necessary.

As to Claim 1, Appellants would be willing to amend the claim to recite "a non-transitory machine readable medium" if this were considered by the Board to be necessary.

B. Separate Steps

The Examiner has answered that "clearly the user identification and list selection are separate steps in the Ellis reference." The Examiner suggests that Ellis shows that there is a Figure 10 user identification operation and then a Figure 18 list selection operation.

However, the sections cited by the Examiner do not refer to user identification but to activating an appropriate profile. As shown in Figure 16, the profiles are generally associated with particular user names.

Appellant would agree that in Ellis a user first activates a profile and then can be presented with the display in Figure 18. The issue is whether the items in Figure 18 are "multiple stored preferences lists corresponding to the current user" as recited in the claims. Appellants assert that the display format options 182 of Figure 18 do not anticipate the claims, as explained in Appellant's Brief and in more detail below.

C. A Plurality of Program Lists

The Examiner has also answered that "Figure 18 of Ellis shows navigator menu 184 includes a plurality of program lists." The Examiner continues that "when a category is selected a list of content that fits that category is displayed to the user."

Appellants agree that Figure 18 shows different categories that the user can select and that when such a category is selected there can be a list of programs such as shown in Figure 19.

However, Claim 1, for example, is not met simply by such a feature.

Claim 1 recites, " identifying multiple stored preferences lists corresponding to the current user" The Examiner proposes next that the lists of Ellis Figure 18 are stored but this is not stated at Col. 12, lines 4-8. Appellants are unable to find any disclosure that the lists are stored and the Examiner has failed to point to any such disclosure.

Column 12, lines 1-3 states that "the dedicated favorites display format may be e.g. a time-ordered list of programs that meet the criteria set forth in the currently active profile." Rather than suggesting a stored list for the active profile, this statement

describes a "display format." There is nothing to say that such a list is stored but rather that it is a format of displaying a larger general list. The overall impression from Ellis is that there is a single master list and the system applies filters in order to generate particular displays.

The Examiner might argue that in order to produce a display format, the list of that display must be stored. Certainly, some data representing the list must be placed in a display buffer and perhaps also a filter results cache somewhere in the system. However, the stored lists of Claim 1 must be identified and searched after receiving a user identification and before "providing a list display of the identified stored preferences lists." This is not the same type of storage required to support a Figure 19 type display.

Claim 1, recites, "searching a set of stored preferences lists." Ellis speaks instead of "restricting the display" or "restricting the movement of the highlight region on the screen." This suggests that rather than searching stored lists, Ellis has a single list and filters it to generate e.g. the Figure 19 display.

Summing up, Ellis presents a fundamentally different approach in which the display is changed by restriction depending upon the display format options. Claim 1 provides for multiple lists that are pre-stored and can be selected by user command.

For these reasons, Claim 1 is believed to traverse the rejections. The remaining claims are believed to be allowable on the same grounds, *inter alia*.

VII. CONCLUSION

Appellant respectfully submits that all appealed claims in this application are patentable and were improperly rejected by the Examiner during prosecution before the United States Patent and Trademark Office. Appellant respectfully requests that the Board of Patent Appeals and Interferences overrule the Examiner and direct allowance of the rejected claims.

Please charge any shortages and credit any overpayments to our Deposit Account No. 02-2666.

Respectfully submitted,

BLAKELY, SOKOLOFF, TAYLOR & ZAFMAN LLP

Dated: July 1, 2010



Gordon R. Lindeen III
Reg. No. 33,192

1279 Oakmead Parkway
Sunnyvale, California 94085
(303) 740-1980